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HICKMAN PALERMO TRUONG & BECKER/ORACLE
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110-1083

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| BETIT, JACOB F | |

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* ASHISH THUSOO

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Appeal 2009-012801
Application 10/662,095[1]
Technology Center 2100

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Before ERIC S. FRAHM, GREGORY J. GONSALVES, and MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Filed on September 12, 2003. The real party in interest is Oracle International Corp. (App. Br. 3.)

## I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) (2002) from the Examiner's Non-Final Rejection of claims 1-20 and 22-25. (App. Br. 3;[2] Reply Br. 2.) Claim 21 has been cancelled. (*Id.*) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We reverse.

### *Appellant's Invention*

Appellant invented a method and computer-readable medium directed to returning clauses in Data Manipulation Language (hereinafter "DML") commands. (Spec. 2, ¶ [0001].)

### *Illustrative Claim*

1. A method comprising:

receiving a database statement that

specifies a data manipulation language (DML) operation that modifies data in one or more columns in a database, and

contains a clause that specifies an aggregate operation to be performed on a plurality of values associated with the data, wherein each of the plurality of values are from a separate row; and

in response to receiving the database statement,

performing the DML operation on the one or more columns in the database,

[2] All references to the Appeal Brief are to the Supplemental Appeal Brief field on August 21, 2007, which replaced the Appeal Brief filed on March 30, 2007.

performing the aggregate operation on the plurality of values, and

returning as a result of the database statement a result of the aggregate operation.

*Prior Art Relied Upon*

| | | |
|---|---|---|
| Ramasamy | US 6,567,803 B1 | May 20, 2003 |

"*PL/SQL User's Guide and Reference*," Release 2 (9.2), Mar. 2002, Ch. 5—pgs. 51-55, Ch. 6—pgs. 1-2, Ch. 12—pgs. 1-13 (hereinafter "Reference [A]").

Oracle Corp., Oracle9i SQL Reference, Release 2 (9.2) (hereinafter "Reference [B]").

Appellant's Admitted Prior Art located on pgs. 4-5 in the Background section of Appellant's Specification (hereinafter "AAPA").

*Rejections on Appeal*

Claims 1-7, 10, 14-20, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reference [A] and AAPA.

Claims 8, 9, 11, 13, 22, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reference [A], AAPA, and Reference [B].[3]

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[3] In the Non-Final Rejection enter December 22, 2006, the Examiner appears to have rejected dependent claims 8, 9, 11, 13, 22, and 24 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reference [A] and Reference [B]. (Non-Fin. Rej. 5-8; *see also* Ans. 6-8.) However, we note that independent claims 1 and 15, from which claims 8, 9, 11, 13, 22, and 24 depend, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reference [A] and AAPA. (Fin. Rej. 3 and 5; *see also* Ans. 4-5.) Therefore, since AAPA is part of the rejection of independent claims 1 and 15, we will treat dependent claims 8, 9, 11, 13, 22, and 24 as

Claims 12 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reference [A], AAPA, Reference [B], and Ramasamy.[4]

*Appellant's Contentions*

Appellant contends that since Reference [A] discloses that the RETURNING clause can only be used when operating on exactly one row, Reference [A] teaches away from the claimed invention. (App. Br. 11-12; Reply Br. 6-7.) Moreover, Appellant argues that modifying Reference [A]'s RETURNING clause with AAPA would change the principle operation of the RETURNING clause (i.e., to return a single row when a value in that row has changed). (Reply Br. 7.)

*Examiner's Findings and Conclusions*

The Examiner finds that Appellant fails to recognize the distinction between not teaching a limitation and teaching away. (Ans. 13.) In particular, the Examiner finds that although you can only use the RETURNING clause when operating on one row, Reference [A] does not go as far to teach or suggest that an ordinarily skilled artisan would not appreciate programing the functionality of acting on multiple rows into the RETURNING clause, or that an ordinarily skilled artisan would not appreciate performing an aggregate function in the RETURNING clause. (*Id.*)

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being rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reference [A], AAPA, and Reference [B].

[4] For similar reasons as set forth in the previous footnote, we will treat dependent claims 12 and 23 as being rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reference [A], AAPA, Reference [B], and Ramasamy.

## II. ISSUE

The dispositive issue before us is whether the Examiner erred in concluding that the combination of Reference [A] and AAPA renders independent claim 1 unpatentable? In particular, the issue turns on whether Reference [A]'s RETURNING clause teaches away from the claimed invention…namely "returning as a result of the database statement a result of the aggregate operation," whereby such result pertains to "an aggregate operation to be performed on a plurality of values associated with the data, wherein each of the plurality of values are from a separate row," as recited in independent claim 1.

## III. FINDINGS OF FACT

The following Findings of Fact (hereinafter "FF") are shown by a preponderance of the evidence.

*Reference [A]*

FF 1. Reference [A] discloses that "[t]he INSERT, UPDATE, and DELETE statements can include a RETURNING clause, which returns column values from the affected row into a PL/SQL record variable." (Ch. 5, pg. 53) In particular, Reference [A] discloses that "*[y]ou can use this clause [the RETURNING clause] only when operating on exactly one row.* (*Id.*) (Emphasis added.)

## IV. ANALYSIS

*Claim 1*

We find error in the Examiner's rejection of independent claim 1 because Reference [A]'s RETURNING clause can only be used when

operating on exactly one row and, therefore, Reference [A] teaches away from the claimed invention. "What the prior art teaches and whether it teaches toward or away from the claimed invention … is a determination of fact." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

At best, Reference [A]'s disclosure of a RETURNING clause that can only be used when operating on exactly one row (FF 1) teaches or suggests that the RETURNNG clause can only return a single row when a value in that row has been inserted, updated, or deleted. Moreover, since this explicit disclosure in Reference [A] uses restrictive words such as "only" and "exactly," we find that an ordinarily skilled artisan would have been discouraged from modifying the RETURNING clause to include the ability to operate on separate rows (i.e., return values from separate rows when a value in each row has been inserted, updated, or deleted). Put another way, Appellant has pointed to an explicit disclosure within Reference [A] that acts to criticize, discredit, or otherwise discourage the claimed "returning as a result of the database statement a result of the aggregate operation," whereby such result pertains to "an aggregate operation to be performed on a plurality of values associated with the data, wherein each of the plurality of values are from a separate row." *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Therefore, we agree with Appellant that Reference [A] teaches away from the claimed invention. (*See* App. Br. 11-12; Reply Br. 6-7.) Further,

we find that AAPA does not remedy the noted deficiency in the Examiner's rejection.

Since Appellant has shown at least one error in the rejection of independent claim 1, we need not reach the merits of Appellant's other arguments. It follows that the Examiner erred in concluding that the combination of Reference [A] and AAPA renders independent claim 1 unpatentable.

*Claims 2-7, 10, and 16-20*

Since independent claim 15, and dependent claims 2-7, 10, and 16-20, also incorporate the same claim limitations discussed *supra*, and Reference [A]'s RETURNING clause teaches away from such claim limitations, we find that the Examiner erred in rejecting these claims for the same reasons set forth in our discussion of independent claim 1.

*Claims 8, 9, 11-14, and 22-25*

We find that neither Reference [B] nor Ramasamy remedy the noted deficiency in the Examiner's rejection. Therefore, since dependent claims 8, 9, 11-14, and 22-25 incorporate by a reference the same claim limitations discussed *supra*, and Reference [A]'s RETURNING clause teaches away from such claim limitations, we find that the Examiner erred in rejecting these claims for the same reasons set forth in our discussion of independent claim 1.

## V. CONCLUSION OF LAW

The Examiner erred in rejecting claims 1-20 and 22-25 as being unpatentable under 35 U.S.C. § 103(a).

## VI. DECISION

We reverse the Examiner's decision to reject claims 1-20 and 22-25 as being unpatentable under 35 U.S.C. § 103(a).

REVERSED

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